

REMARKS

This paper is submitted in response to the pending Office Action mailed on October 20, 2006. Because this Response electronically submitted and certified according to 37 C.F.R. §1.4, on or before the shortened period for reply set to expire on **January 20, 2007**, this Response is timely filed.

I. STATUS OF THE CLAIMS

Prior to this Response, claims 1 to 24 were pending and at issue. None of the claims have been amended and no claims have been added or canceled. Thus, claims 1 to 24 remain pending and at issue in this application.

While Applicant believes that no additional fees are due in connection with this application, Applicant directs the Office to charge **Deposit Account No. 23-1925 (08285-00636)** for any fees deemed owed during the pendency of this application, excluding the issue fee.

II. CLAIM REJECTIONS

The Office Action rejects: claims 1 to 12 on the ground of non-statutory obviousness-type double patenting over U.S. Patent No. 6,625,261; and claim 13 to 14 under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,876,729 to Kuter et al. ("*Kuter*").

A. ALLEGED OBVIOUSNESS-TYPE DOUBLE PATENTING

Applicant respectfully traverses the rejection of claim 1 to 12 based on the judicially created doctrine of non-statutory double patenting over U.S. Patent No. 6,625,261. In light of the contemporaneously submitted, and properly executed, terminal disclaimer attached herewith in the Appendix, Applicant asserts that the pending rejections have been rendered moot. Applicant respectfully requests reconsideration and withdrawal of the same.

B. CLAIM REJECTIONS ALLEGED UNDER 35 U.S.C. §102(e)

Applicant respectfully traverses the rejections of claims 13 to 24 as anticipated¹ by *Kuter*. In particular, *Kuter* does not disclose each and every element

¹ "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v.*

set of in the claims 13 to 24. For example, independent claim 13 recites, in relevant part, playing back a voicemail message and *during the playback of the voicemail message, receiving a bookmark request*. Then, upon receiving a request for playback, playing back the voicemail message starting at a point preceding a point in the voicemail message at which the bookmark request was received. In other words, **a listener can generate a bookmark within the message they are listening to**, and then subsequently replay the message from the point of the bookmark. Similarly, independent claim 17 generally recites a telecommunication system that receives a bookmark request during the playing back of a voicemail message and then plays back the voicemail message starting at a point preceding a point in the voicemail message at which the bookmark request was received. Independent claim 21 generally recites a computer-usable medium that includes means for receiving a request for playing back the voicemail message and means for playing back the voicemail message starting at a point preceding a in the voicemail message at which the bookmark request was received.

Kuter does not disclose or suggest such a system. In fact, the system of *Kuter* works in a manner that is substantially opposite to the system and method recited in the claim 1 to 24. *Kuter* recites:

a voice message author begins recording the voice message. In the second step 84, **the voice message author marks the voice message with a first bookmark**, using a user interface, while continuing to record the voice message. *See Kuter* at col. 3, lines 11 to 15. [Emphasis added.]

In other words, the message creator or recorder, and not the listener, bookmarks and annotates the message during the creation process. Thus, the system of *Kuter* deals with how the message creator records or creates and bookmarks a new message, and not how the listener replays and bookmarks a message previously recorded or created by the message creator.

Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). *See* MPEP §2131.

Moreover, Applicant respectfully submits that the passage of the *Kuter* cited in the Office Action at page 3, paragraph 5, lines 9 to 10, does not disclose, teach or even suggest playing back a voicemail message and during the playback of the voicemail message, receiving a bookmark request. In fact, the relied upon passage of *Kuter* recites:

a listener, such as a voice message recipient, selects the bookmarked voice message [and ...] playback begins at the bookmark and the listener listens to the bookmarked voice message beginning at the bookmark. *See Kuter* at col. 3, lines 29 to 35.

In other words, the listener selects **a message that has been previously bookmarked by the message creator** but does not create the bookmarks themselves. Thus, while the system if *Kuter* allows for playback from the point of a bookmark created by the message creator, the system of *Kuter* does not disclose, teach or even suggest that the **listener** can bookmark the message during playback.

Because *Kuter* does not disclose or even suggest each and every element set forth in the claims, *Kuter* cannot anticipate claims 13 to 24. Moreover, because *Kuter* does not disclose the all of the elements recited in claims 13 to 24, no combination or modification of *Kuter* would result in the claimed system or method. Furthermore, because *Kuter* operates and functions in a manner opposite of the claimed system and method, there exists no suggestion or motivation to even attempt to modify *Kuter* to yield the system and method recited in claims 13 to 24. For at least these reasons, Applicant submits that claim 13 to 24 are novel and not anticipated.

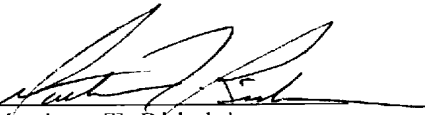
Applicant respectfully requests reconsideration and withdrawal of the pending anticipation rejection.

III. CONCLUSION

For the foregoing reasons, Applicant respectfully requests withdrawal of the pending rejections and submits that the above-identified patent application is now in condition for allowance and earnestly solicits reconsideration of same. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting prosecution of this application.

Respectfully submitted,

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Dated: **December 27, 2006**

APPL. NO. 10/626,462
RESP. DATED DEC. 27, 2006
RESP. TO OFFICE ACTION OF OCT. 20, 2006.

ATTY. DOCKET NO.: 08285-00636

APPENDIX